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Request for Reconsideration of Restriction  
Requirement mailed 1/7/99 pursuant to 37 CFR 1.143

Applicant(s): Daniel Anthony Gately

Title: Silylated and N-silylated Compound Synthesis

Serial No.: 09/016,641

Filing Date: 1/30/98

vgc



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of :  
: DANIEL ANTHONY GATELY : Art Unit: 1621  
: Serial No.: 09/016,641 : Examiner: J. Vollano  
: Filed: January 30, 1998 :  
: FOR: Silylated and N- :  
: Silylated compound :  
: Synthesis :

REQUEST FOR RECONSIDERATION OF RESTRICTION REQUIREMENT  
MAILED JANUARY 7, 1999 PURSUANT TO 37 C.F.R. §1.143

Honorable Commissioner of  
Patents and Trademarks  
Washington, D.C. 20231

Sir:

IN THE CLAIMS

Claim 8, line 4, delete "or a claim 7".

REQUEST FOR RECONSIDERATION

Applicant disagrees with the requirement for restriction mailed January 7, 1999. Pursuant to 37 C.F.R. §1.143, applicant requests reconsideration and withdrawal or modification of the requirement for the reasons set forth herein.

Consistent with 37 C.F.R. §1.143's requirement for only a provisional election and paragraph 8 of the restriction requirement, applicant provisionally elects the examiner's Invention "V", i.e., claims 9-13.

### REASONS FOR REQUEST

1. Each of the examiner's "inventions" I-IV purport to be based on portions of claims, e.g., "Claims 1-3(in part)" (examiner's invention "I"). Pursuant to 35 U.S.C. §103(a), claimed inventions are to be considered and acted upon by the examiner "as a whole". The restriction requirement cites no authority, rule or regulation for predicating restriction only on a "part" of a claim. For that reason alone, each of the examiner's purported inventions "I-IV" is inappropriate. Therefore, the restriction requirements as between or among any of the examiner's inventions "I-IV" should be withdrawn.

2. The restriction requirement is illogical and inconsistent in the following respects:

(a) The examiner's invention "I" includes "Claims 1-3(in part) and 4"; whereas, the examiner's invention "II" includes "Claims 1-3(in part), 5-6 and 14-15". If, as the examiner's invention "I" admits, claim 4 can properly be examined with claims 1-3, then claim 4 can properly be examined in connection with claims 1-3, 5-6 and 14-15 which comprise the examiner's invention "II".

The assertion in paragraph 2 of the restriction requirement that inventions "I" and "II" are "unrelated" is contradicted by

the fact that "Claims 1-3(in part)" are included in each of inventions "I" and "II".

Inventions "I" and "II" should be combined to yield a single "invention".

(b) The examiner's invention "III" includes only "Claim 7(in part)"; whereas, examiner's invention "IV" includes "Claims 7(in part) and 8". If claim 8 is properly examined with "Claim 7(in part)", the restriction between the examiner's inventions "III" and "IV" is inappropriate for the same reason that the requirement for restriction between inventions "I" and "II" is wrong.

3. Referring to paragraph 5 of the restriction requirement, the assertion that "Inventions III, IV and V are unrelated" contradicts the text of the claims which comprises these "inventions". Claim 7 defines "[a] method for preparing a silylated or N-silylated mono- or bis- cyclopentadienyl or indenyl compound". Claim 8 is limited to a method of preparing a species of the same N-silylated compound defined by claim 7. Note in this regard that the compound of claim 6 referenced in claim 8 is a species of a claim 1 compound; whereas, claim 7 also specifies a compound of claim 1 (ll. 4-5).

The reference to claim 7 in line 4 of claim 8 is inappropriate and has been cancelled by this response.

As appears from the text of claims 7 and 8, the assertion in paragraph 5 of the restriction requirement that "invention III is a method of preparing organosilyl [sic] aromatic compounds wherein invention IV forms nitrogen silyl compounds with different chemical and physical properties" is incorrect. Both claim 7 (invention "III") and claim 8 (invention "IV") are methods for preparing organosilyl compounds including nitrogen silyl compounds. The examiner has cited no evidence and can cite no evidence to justify the fact-finding that the invention "III" and "IV" compounds are distinguished in any way which justifies the restriction requirement between "Claim 7 (in part)" (invention "III") and the same claim 7 (in part) together with claim 8 (invention "IV").

It is suggested that the restriction requirement be reformulated to combine the examiner's inventions "I" and "II" into a single invention which includes claims 1-6 and 14-15 and that the examiner's inventions "III" and "IV" be combined into a single invention which includes both of claims 7 and 8. In every instance, the restriction must be based upon the claims in their entirety, not "in part".

Further, even if the requirement is reformulated as suggested, the requirement for restriction as between any of the examiner's inventions "I" to "IV" is traversed. Note again that claims 7 and 8 specify claim 1 compounds.

If the restriction requirement is modified, the provisional election of the examiner's invention "V" is automatically voided.



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